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EXAMINER				
ROSEN, ELIZABETH H				
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3692				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com

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Office Action Summary

Application No.

10/531,735

Applicant(s)

TANAKA, SHIN-ICHI

Examiner

ELIZABETH ROSEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the Amendment and Response filed on February 4, 2008.
2. Claims 1-3, 5, 8, 12, 17, and 23 have been amended.
3. Claims 1-23 are currently pending and have been examined.

Response to Arguments

4. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

5. Examiner would like to point out that the Supreme Court in *KSR International Co. v. Teleflex Inc.* described seven rationales to support rejections under 35 U.S.C. 103:

- Combining prior art elements according to known methods to yield predictable results;
- Simple substitution of one known element for another to obtain predictable results;
- Use of known technique to improve similar devices (methods, or products) in the same way;
- Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- "Obvious to try" –choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and
- Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art. The prior art reference (or references when combined) need not teach or suggest all the claim limitations; however, Office personnel must explain why the difference(s) between the prior

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art and the claimed invention would have been obvious to one of ordinary skill in the art. The "mere existence of differences between the prior art and an invention does not establish the invention's nonobviousness." see *Dann v. Johnson*, 425 U.S. 219, 230 (1976).

6. In light of the new ground of rejection based on Applicant's amendments, Applicant's arguments are moot.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claim 17** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 includes the limitation of "with is depreciated with respect to time." For purposes of examination, it was interpreted to mean "which is depreciated with respect to time."

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claim 5 and 6** are rejected under 35 U.S.C. 102(e) as being anticipated by **Oneda**, U.S. Patent Number 6,611,819 B1.

Claim 5:

Oneda teaches:

- by the computer system, at a predetermined timing of settlement, only when the settlement is performed using the first electronic money in combination with the second electronic money, allowing an amount equal to at least a part of the

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amount of a claim to be reduced from the balance of the first electronic money, wherein an upper limit of a proportion of the first electronic money to a total amount to be paid is provided (see at least Oneda, Figure 12 and column 24, lines 30-67).

Claim 6:

Oneda further teaches:

- wherein a lower limit of an amount to be paid by the first electronic money is provided (see at least Oneda, Figure 12 and column 24, lines 30-67).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1-4, 12, 14, and 16-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Oneda**, U.S. Patent Number 6,611,819 B1 in view of **Gineris**, U.S. Patent Number 5,285,384.

Claim 1:

Oneda discloses the limitations of:

- by the computer system, at a predetermined timing of settlement, reading the balance of first electronic money from the recording medium (see at least Oneda, Figure 12 and column 15, lines 12-21);
- acquiring amount of a claim (see at least Oneda, Figure 12);
- by reducing the balance of the first electronic money at a predetermined rate based on a difference between a predetermined reference date and a settlement date and using the reduced balance as a new balance of the first electronic money (see at least Oneda, Figure 12); and
- reducing an amount equal to at least a part of the amount of the claim at the time of the settlement, from the reduced balance of the first electronic money (see at least Oneda, Figure 12).

Oneda does not disclose, but **Gineris**, however, does disclose:

- depreciating the first electronic money with respect to time and without a purchase (see at least Gineris, Figure 4 and column 5, lines 37-46 (Employers can set up electronic direct deposits where funds are automatically deducted from the employer's account and deposited into the employee's account on a periodic basis.)); and
- automatically transferring the reduced part of the balance of the first electronic money to a predetermined account (see at least Gineris, Figure 4 and column 5, lines 37-46 (Employers can set up electronic direct deposits where funds are automatically deducted from the employer's account and deposited into the employee's account on a periodic basis.)).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate Gineris' method of direct deposits with Oneda's electronic money apparatus, method, and card. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of making automatic payments at predetermined times for many purposes, including employee salary payments.

Claim 2:

Oneda further discloses:

- when a balance of second electronic money which is not depreciated with time is recorded in the recording medium, in addition to reducing of a part of the amount of claim from the balance of the first electronic money, reducing the remaining amount of the claim from the balance of the second electronic money (see at least Oneda, column 24, lines 30-67).

Claim 3:

Oneda further discloses:

- wherein an upper limit of a proportion of the first electronic money to a total amount to be paid is provided (see at least Oneda, Figure 12 and column 24, lines 30-67).

Claim 4:

Oneda further discloses:

- wherein a lower limit of an amount to be paid by the first electronic money is provided (see at least Oneda, Figure 12 and column 24, lines 30-67).

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Claim 12:

Oneda discloses the limitations of:

- information of a balance of first electronic money (see at least Oneda, Figure 12 and column 24, lines 30-67);
- information of a balance of second electronic money which is not depreciated with respect to time (see at least Oneda, Figure 12 and column 24, lines 30-67); and
- information indicative of an upper limit of a proportion of the first electronic money to a total amount to be paid at a time of settlement performed by the processing device with a combination of the first and second electronic money (see at least Oneda, Figure 12 and column 24, lines 30-67).

Oneda does not disclose, but **Gineris**, however, does disclose:

- which is depreciated with respect to time (see at least Gineris, Figure 4 and column 5, lines 37-46 (Employers can set up electronic direct deposits where funds are automatically deducted from the employer's account and deposited into the employee's account on a periodic basis.)).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate Gineris' method of direct deposits with Oneda's electronic money apparatus, method, and card. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of making automatic payments at predetermined times for many purposes, including employee salary payments.

Claim 14:

Oneda further discloses:

- a lower limit of an amount to be paid by the first electronic money (see at least Oneda, Figure 12 and column 24, lines 30-67).

Claim 16:

Oneda further discloses:

- reads the information recorded in the recording medium according to claim 12, depreciates balances of first electronic money and second electronic money recorded in the recording medium so that the depreciated total becomes equal to an amount of payment, based on information showing an upper limit of a proportion of the first electronic money to a total amount to be paid, and

increases electronic money of a recipient of the payment by the amount of payment (see at least Oneda, Figure 12 and column 24, lines 30-67).

Claim 17:

Oneda discloses the limitations of:

- recording a balance of first electronic money in the recording medium (see at least Oneda, Figure 12 and column 24, lines 30-67); and
- at the time of settlement, allowing the first electronic money to be used for the settlement when an amount of payment is more than a predetermined amount, or prohibiting the first electronic money from being used when the amount of payment is less than the predetermined amount (see at least Oneda, Figure 12 and column 24, lines 30-67).

Oneda does not disclose, but Gineris, however, does disclose:

- with is depreciated with respect to time (see at least Gineris, Figure 4 and column 5, lines 37-46 (Employers can set up electronic direct deposits where funds are automatically deducted from the employer's account and deposited into the employee's account on a periodic basis.)).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate Gineris' method of direct deposits with Oneda's electronic money apparatus, method, and card. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of making automatic payments at predetermined times for many purposes, including employee salary payments.

Claim 18:

Oneda further discloses:

- recording a balance of second electronic money in the recording medium or another recording medium (see at least Oneda, Abstract; Figure 12; and column 24, lines 30-67); and
- settling a payment using the first electronic money and the second electronic money when an amount of payment is more than the predetermined amount, at a timing of settlement (see at least Oneda, Abstract; Figure 12; and column 24, lines 30-67).

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13. **Claims 7 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Oneda**, U.S. Patent Number 6,611,819 B1 in view of **Churchill**, et al., PCT No. WO 01/29750.

Claim 7:

Oneda does not disclose, but **Churchill**, however, does disclose:

- wherein an expiration date of the first electronic money is provided (see at least Churchill, Abstract; Page 31, line 21 through Page 32, line 25).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate Churchill's feature with Oneda's electronic money apparatus, method, and card. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of motivating customers to purchase products to avoid losing credit (see Churchill, Page 5, lines 25-31).

Claim 23:

Oneda discloses the limitations of:

- by the computer system (see at least Oneda, Abstract; Figure 12; and column 24, lines 30-67);
- updating the balance of the electronic money recorded in the recording medium with the depreciated balance (see at least Oneda, Abstract; Figure 12; and column 24, lines 30-67); and
- moving ownership of monetary value of the depreciated amount to others (see at least Oneda, Abstract; Figure 12; and column 24, lines 30-67).

Oneda does not disclose, but **Churchill**, however, does disclose:

- depreciating the balance of the electronic money at a predetermined rate when a predetermined period passes from a reference date (see at least Churchill, Abstract; Page 31, line 21 through Page 32, line 25).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate Churchill's feature with Oneda's electronic money apparatus, method, and card. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of motivating customers to purchase products to avoid losing credit (see Churchill, Page 5, lines 25-31).

14. **Claims 8, 11, and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Churchill**, et al., PCT No. WO 01/29750, in view of **Gineris**, U.S. Patent Number 5,285,384.

Claim 8:

Churchill discloses the limitations of:

- information of a balance of first electronic money which is depreciated...by the processing device (see at least Churchill, Abstract; Page 31, line 21 through Page 32, line 25); and
- a depreciation rate which is used by the processing device for depreciating the depreciated electronic money, the depreciation rate being a ratio between balances of the first electronic money before and after depreciating the first electronic money (see at least Churchill, Abstract; Page 31, line 21 through Page 32, line 25).

Churchill does not disclose, but Gineris, however, does disclose:

- with respect to time (see at least Gineris, Figure 4 and column 5, lines 37-46 (Employers can set up electronic direct deposits where funds are automatically deducted from the employer's account and deposited into the employee's account on a periodic basis.)).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate Gineris' method of direct deposits with Churchill's auction redemption system and method. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of making automatic payments at predetermined times for many purposes, including employee salary payments.

Claim 11:

Churchill further discloses:

- information of a depreciation date which shows a timing on which the first electronic money is depreciated (see at least Churchill, Abstract; Page 31, line 21 through Page 32, line 25).

Claim 15:

Churchill further discloses:

- depreciates a balance of depreciated electronic money recorded in the recording medium at the depreciation rate based on elapsed days from a predetermined reference date (see at least Churchill, Abstract; Page 31, line 21 through Page 32, line 25).

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15. **Claims 9, 10, and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Churchill**, et al., PCT No. WO 01/29750, in view of **Gineris**, U.S. Patent Number 5,285,384, and further in view of **Oneda**, U.S. Patent Number 6,611,819 B1.

Claim 9:

Churchill does not disclose, but **Oneda**, however, does disclose:

- information of a balance of second electronic money which is not changed in value with time (see at least Oneda, Figure 12; and column 24, lines 30-67); and
- an upper limit of a proportion of the first electronic money to a total amount to be paid at the time of settlement (see at least Oneda, Figure 12; and column 24, lines 30-67).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate Oneda's feature with Churchill's auction redemption system and method. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of allowing the transfer and settlement processing for two separate groups of electronic money (see Oneda, column 5, lines 45-65).

Claim 10:

Churchill does not disclose, but **Oneda**, however, does disclose:

- information of a lower limit of an amount to be paid by the first electronic money (see at least Oneda, Abstract; Figure 12; and column 24, lines 30-67).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate Oneda's feature with Churchill's auction redemption system and method. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of allowing the transfer and settlement processing for two separate groups of electronic money (see Oneda, column 5, lines 45-65).

Claim 22:

Churchill does not disclose, but **Oneda**, however, does disclose:

- allows the first electronic money to be used when an amount of payment is more than a predetermined amount, or prohibits the first electronic money from being used for the settlement when the amount of payment is less than the predetermined amount (see at least Oneda, Abstract; Figure 12; and column 24, lines 30-67).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate Oneda's feature with Churchill's auction redemption system and method. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of allowing the transfer and settlement processing for two separate groups of electronic money (see Oneda, column 5, lines 45-65).

16. **Claims 13 and 19-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Oneda**, U.S. Patent Number 6,611,819 B1 in view of **Gineris**, U.S. Patent Number 5,285,384, and further in view of **Churchill**, et al., PCT No. WO 01/29750.

Claim 13:

Oneda does not disclose, but **Churchill**, however, does disclose:

- information showing an expiration date of the first electronic money (see at least Churchill, Abstract; Page 31, line 21 through Page 32, line 25).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate Churchill's feature with Oneda's electronic money apparatus, method, and card. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of motivating customers to purchase products to avoid losing credit (see Churchill, Page 5, lines 25-31).

Claim 19:

Oneda does not disclose, but **Churchill**, however, does disclose:

- wherein the first electronic money is depreciated with time (see at least Churchill, Abstract; Page 31, line 21 through Page 32, line 25).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate Churchill's feature with Oneda's electronic money apparatus, method, and card. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of motivating customers to purchase products to avoid losing credit (see Churchill, Page 5, lines 25-31).

Claim 20:

Oneda does not disclose, but **Churchill**, however, does disclose:

- calculating a balance of the first electronic money after being depreciated based on a difference between a predetermined date and a settlement date and

depreciation information showing a degree of depreciation of the first electronic money, the depreciation information recorded in the recording medium (see at least Churchill, Abstract; Page 31, line 21 through Page 32, line 25).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate Churchill's feature with Oneda's electronic money apparatus, method, and card. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of motivating customers to purchase products to avoid losing credit (see Churchill, Page 5, lines 25-31).

Claim 21:

Oneda does not disclose, but Churchill, however, does disclose:

- wherein an expiration date is set in the first electronic money (see at least Churchill, Abstract; Page 31, line 21 through Page 32, line 25).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate Churchill's feature with Oneda's electronic money apparatus, method, and card. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of motivating customers to purchase products to avoid losing credit (see Churchill, Page 5, lines 25-31).

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Rosen whose telephone number is 571-270-1850. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nga B. Nguyen/

Primary Examiner, Art Unit 3692